



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/589,497	08/15/2006	Isao Miyagawa	0033-1091PUS1	9861

2292 7590 10/28/2011
BIRCH STEWART KOLASCH & BIRCH
PO BOX 747
FALLS CHURCH, VA 22040-0747

EXAMINER

JANSSEN, SHANNON L

ART UNIT	PAPER NUMBER
----------	--------------

1653

NOTIFICATION DATE	DELIVERY MODE
-------------------	---------------

10/28/2011

ELECTRONIC

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

mailroom@bskb.com

Advisory Action Continued

The amendment filed October 14, 2011 under 37 CFR 1.116 in reply to the final rejection has been considered but is not deemed to place the application in condition for allowance and will not be entered because of the following:

a. The proposed amendment requires further consideration and/or search (e.g. the new limitation “one or more solutions” of claim 1 and the new limitation “more than one sample biopolymer solution is contacted with more than one hydrophilic regions on the glass slide...” of claim 9, which limitations change the scope of the previously examined claims). In accordance with MPEP 803.02, should applicant overcome a rejection by amending a claim, the search concerning amended claims will need to be altered to the extent necessary to determine patentability.

b. The proposed amendment may necessitate the modification of outstanding rejection(s) to address the new limitation (e.g. the new limitation “one or more solutions” of claim 1 and the new limitation “more than one sample biopolymer solution is contacted with more than one hydrophilic regions on the glass slide...” of claim 9, which limitations change the scope of the previously examined claims).

c. The proposed amendment may necessitate the raising of new prior art rejections (e.g. the new limitation “one or more solutions” of claim 1 and the new limitation “more than one sample biopolymer solution is contacted with more than one hydrophilic regions on the glass slide...” of claim 9, which limitations change the scope of the previously examined claims).

d. The proposed amendment may necessitate the raising of new 112 issues (e.g. the new limitation “one or more solutions” of claim 1 and the new limitation “more than one sample

Art Unit: 1636

biopolymer solution is contacted with more than one hydrophilic regions on the glass slide...” of claim 9, which limitations change the scope of the previously examined claims).

e. There is no convincing evidence under 37 CFR 1.116(b) why the proposed amendment was not earlier presented.

f. Applicants arguments of the 112 rejections of record are moot since the arguments are based on the proposed amendments that have not been entered.

g. For all the reasons above, the amendment does not place the application in better condition for allowance and/or appeal.

Response to Arguments

Applicant's arguments filed October 14, 2011 have been fully considered but they are not persuasive for the following reasons. Applicants' arguments are presented in Italics.

Applicants assert that the references cannot be combined without changing the principle of operation (Response, p 7-8).

In response to applicant's argument that it would not be possible to spot the probes onto the slides of Thurnheer since the hydrophobic regions are not formed until after the probes are synthesized, the test for obviousness is not whether the features of a secondary reference may be bodily incorporated into the structure of the primary reference; nor is it that the claimed invention must be expressly suggested in any one or all of the references. Rather, the test is what the combined teachings of the references would have suggested to those of ordinary skill in the art. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981). In the instant case, McCormick et al. teach the benefits of having hydrophobic regions to separate various subarrays in order to prevent cross contamination of different samples. This, in combination with

Art Unit: 1636

Thurnheer et al., would lead one of skill in the art to utilize slides with hydrophobic barriers as taught by McCormick et al. in order to separate the samples in the hybridization method taught by Thurnheer et al. Contrary to applicants assertions, the modification of Thurnheer et al. with McCormick et al. would not require a substantial reconstruction and redesign of the probes shown in the primary Thurnheer reference as one of ordinary skill in the art would recognize that many different types of probes could be used and that probes could be spotted after construction of the array.

Future Communications

Any inquiry concerning this communication or earlier communications from the examiner should be directed to SHANNON JANSSEN whose telephone number is (571)270-1303. The examiner can normally be reached on Monday-Friday 10:00AM-7:00PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Ardin Marschel can be reached on (571) 272-0718. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Art Unit: 1636

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Shannon L Janssen
SLJ

/CHRISTOPHER M GROSS/
Primary Examiner, Art Unit 1636